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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,769	10/17/2001	Tasneem S. Rangwala	38-21(52249)	4211
27161	7590	06/17/2003		
MONSANTO COMPANY 800 N. LINDBERGH BLVD. ATTENTION: G.P. WUELLNER, IP PARALEGAL, (E2NA) ST. LOUIS, MO 63167			EXAMINER TUNG, JOYCE	
			ART UNIT 1637	PAPER NUMBER 8
			DATE MAILED: 06/17/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/682,769</b>	Applicant(s) <b>Rangwala et al.</b>
Examiner <b>Joyce Tung</b>	Art Unit <b>1637</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Mar 31, 2003

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

4)  Claim(s) 1-21 is/are pending in the application.

4a) Of the above, claim(s) 1-10 and 12-21 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 11 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election without traverse of Group II, claim 11 in Paper No. 7 is acknowledged.
2. Claims 1-10 and 12-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Groups I-II and IV-IX, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - a. Claim 11 recites the limitation "the PV-GHGT07(1445)". There is insufficient antecedent basis for this limitation in the claim.

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b. Claim 11 is vague and indefinite because the phrase "PV-GHGT07(1445)" is unclear as to what nucleic acid sequence would define PV-GHGT07 (1445) event which is for detecting the presence of a genomic/transgene DNA in cottons.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fincher et al. (6,462,258 issued 10/8/2002).

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Fincher et al. disclose a method of making transgenic plant cotton which is glyphosate tolerant transgenic plant (See column 23, lines 11-18, column 38, lines 29-67 and column 39, lines 28-67). Fincher et al. also disclose that the promoter sequence used for constructing transgenic plant can hybridize under stringent condition to a target DNA sequence (See column 15, lines 6-41). The suitable target is cotton which can be used for the identification of gene and regulatory sequence (See column 13, lines 39-63). Fincher et al. also disclose that commercial standard line is line 1445 (pMON17136) that contains the P-FMV promoter driving sequence expression of the CTP2-aroA:CP4 gene/E9 3' (See column 38, lines 59-63) coding sequence for glyphosate tolerant phenotype (See column 38, lines 4-9 and lines 32-40). It appears that the PV-GHGT07(1445) is equivalent to pMON17136 since both are glyphosate tolerant. The transgenic cotton of Fincher et al. has the same functional transgene DNA as the PV-GHGT07(1445) which is glyphosate tolerant transgenic plant (See pg. 5. last paragraph to pg. 7, first paragraph of the specification).

Fincher et al. do not disclose a probe for identifying the presence of a transgene DNA.

One of ordinary skill in the art at the time the invention was made would have been motivated to apply the promoter sequence of Fincher et al to identify the present of transgene DNA corresponding to the PV-GHGT07(1445) in order to carry out the method to identify the present of transgene DNA corresponding to the PV-GHGT07(1445), because Fincher et al. suggest that the promoter sequence used for constructing transgenic plant can hybridize under stringent condition to a target DNA sequence (See column 15, lines 6-41) for identification of the

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transgenic DNA in a transgenic plant. It would have been prima facie obvious to apply the promoter sequence of Fincher et al. used for constructing transgenic plant which has the same functional transgene DNA as PV-GHGT07(1445) in order to carry out the method to identify the present of transgene DNA corresponding to the PV-GHGT07(1445).

### **Summary**

8. No claim is allowable.
9. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.  
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119 on Monday-Friday from 10:00 AM-6:00 PM.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

10. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1637 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

June 6, 2003

*J. T.*  
JEFFREY SIEW  
PRIMARY EXAMINER  
6/14/03